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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: :
BORDON-PALLIER et al : C. Yaen
Serial No.: 09/831,426 :
Filed: May 8, 2001 : Group: 1642
For: HUMAN...PROTEIN :

600 Third Avenue
New York, N.Y. 10016
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PETITION TO THE COMMISSIONER

Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants in the above application hereby petition the Commissioner of Patents and Trademarks to exercise his authority under Rule 181 and review the seven-way restriction requirement that the Examiner has required in the above application. Applicants traversed the said restriction requirement and the Examiner made the same final in the office action of June 4, 2003 on the basis that Applicants' arguments were not convincing because the different inventions referred to different sequences that correspond to different DNA sequence that encode different proteins and therefore, they must be patentably distinct.

In the seven-way restriction requirement, the Examiner required restriction between 5 DNA sequences, claim 14 drawn to a plasmid and claims 10, 11, 15 and 16 drawn to a polypeptide having the function of hTFIIIA and a method of making and using the polypeptide. The Examiner indicated that the groups I to VII did not relate to a

single inventive concept under PCT Rule 13.1 as they lack the same or corresponding technical features. The Examiner was of the opinion that the DNA sequences of inventions I to V were unrelated structurally, functionally and chemically and the method of making and using the protein and the protein were different.

Applicants traversed the restriction requirement on the basis that the European Patent Office had conducted the international search and the international preliminary examination report and did not find a lack of utility as the legal basis. It is believed that the claims should be examined in the same since the MPEP states in Section 1893.03(d), "Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in the national stage filed under 35 USC 371 applications. The restriction practice continues to apply to U.S. national applications filed under 35 USC 11(a)." This invention has been filed under 35 USC 371 and therefore, the issue should be unity of invention and not restriction.

It is believed that the Examiner is misinterpreting Rule 13 of the PCT rules and that the present application deals with an invention group linked to form a single general inventive concept as provided by Rule 13 of the PCT rules. The MPEP states "A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship between the inventions that involve at least one common or corresponding special technical feature." The expression "special technical features" is defined as meaning those technical features that define the contribution which in each claimed application, considered as a whole, makes over the prior art.

Claims 1 to 9 concern DNA sequences which are closely related in that they all share at least a functional relationship as they all code for a protein having the biological function of human transcription factor hTFIIIA and therefore, there is at least one common technical feature for these claims and they should be examined in the same application under PCT Rule 13. This view is in line with Section 1850 of the MPEP wherein it is stated "Further, claims directed to the selected sequences will be examined with claims drawn to any sequence combinations which have a common technical feature with the selected sequences." This is the case for claims 1 to 9 and therefore, they should all be examined together.

Applicants wish to point out that claim 5 is directed to a very large portion of SEQ ID No: 3 which is claimed in claim 3 and the sequence of claim 5 is a coding sequence of SEQ ID No: 3 and therefore, this claim should be included within group I and is not considered a separate invention. Claim 4 is drawn to SEQ ID No: 4 which corresponds in a large part to SEQ ID No: 3 and contains all of the coding portion of SEQ ID No: 3 and therefore, claim 3 should be examined in group I as well and not considered as being separate inventions. These sequences are all coding for an amino acid of SEQ ID No: 2.

With respect to the group drawn to the polypeptide having the function of hTFIIIA, a method of using the protein for diagnosis and treatment, Applicants are of the opinion that claims 1 to 10 should form a single group as they are all linked by a single

general inventive concept as stated in Section 1850 of MPEP. "Further, claims directed to the selected sequences will be examined with claims drawn to any sequence combination which have a common technical feature with the selected sequences. Nucleotide sequences encoding the same protein are considered to satisfy the unity of invention standard and will continue to be examined together." This means that claims 1 to 10 should all be examined together.

Process claim 11 is directed to the preparation of hATFIIIA recombinant protein and claim 11 should be grouped with claims 1 to 10. Combinations of different categories of claims can clearly belong to a single group of invention. It is stated in the MPEP, Section 1850 "The method for determining unit of inventions under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combination of claims of different categories in the same international application...(C) in addition to any independent claim for a given product, an independent claim for a process specifically adapted for the manufacture of the said product and an independent clam for an apparatus or means specifically designed to carry out said process, being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the combination over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art." Process claim 11 is specifically adapted for the manufacture of polypeptides of claim 10 and the means

designed for carrying out this process conclude DNA sequences of claims 1 to 9, the expression vector of claim 12 and the host cells of claim 13. Therefore, according to the Patent Office guidelines, claims 1 to 13 belong to the same group of invention.

Claim 14 is drawn to a plasmid deposited under CNCM I-2071 which plasmids share functional and structural features of claims 1 to 9 as containing the DNA sequence coding for a protein having the biological function of human transcription factor hTFIIIA and therefore, it should belong in the same group. Claims 15 and 16 are drawn to the use of the DNA sequence and polypeptides of claims 1 to 10 and therefore, should belong in the same group as these claims. In other words, all of the claims should be examined in the same application and there is a technical relationship among the invention that involves at least one common or corresponding special technical feature and the unity complies with Rule 13 of the PCT rules.

Therefore, the Commissioner is respectfully requested to reverse the Examiner's restriction requirement and examine claims 1 to 14, 17 and 18 together in the same application.

Respectfully submitted,
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Enclosures